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Dated: April 25, 2007 Signature: 

(Arnold H. Krumholz)

Docket No.: AGALIN 3.0-003 II  
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Fishman et al.

Application No.: 10/631,911

Filed: July 31, 2003

For: METHODS FOR EASING PAIN AND  
ANXIETY FROM ATRIAL OR  
VENTRICULAR DEFIBRILLATION

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: Group Art Unit: 3771  
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: Examiner: Justine R. Yu  
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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REMARKS

Dear Sir:

The following remarks are respectfully submitted preliminary to the initiation of prosecution of this continuation application.

In connection with the improper Notice of Abandonment filed by the Examiner on April 4, 2007, the Examiner took the position that the Declaration which was filed on December 14, 2006, was ineffective to overcome the Hickie and Ujhelyi et al. references. The Examiner then went on to specifically criticize the evidence submitted therein as being insufficient to establish a conception of invention prior to the effective date of Ujhelyi et al. including failure to provide a date of conception and to establish diligence therein. Prior to the

issuance of a first action in this continuing application, however, it is respectfully requested that the Examiner reconsider this position, particularly since applicants submit that the Declaration is entirely sufficient to eliminate Ujhelyi et al. as an appropriate reference in this case.

Ujhelyi et al. has been cited as part of an obviousness rejection in combination with Hickie. Ujhelyi et al. is only available as a reference against the present application under the provisions of 35 U.S.C. § 102(e). That is the case, of course, because Ujhelyi et al. is not a statutory bar under either §§ 102(a) or (b). However, § 102(e) specifically requires that, in order to constitute prior art, the invention must be described in an application filed "by another" before the invention, or a patent granted on an application filed "by another" filed before the invention by applicant. This, of course, is not the case here, as is now clearly established by the Declaration previously submitted by applicants.

The present state of the law is to the effect that an applicant can eliminate a disclosure in a patent or publication by another by showing that the disclosure in fact derived from the applicant's own inventive work, as is precisely the case here. See, *In re Kaplan*, 789 F.2d 1574, 229 U.S.P.Q. 678 (Fed. Cir. 1986); *Lacks Indus., Inc. v. McKechnie Vehicle Components USA Inc.*, 322 F.3d 1335, 1346, 66 U.S.P.Q.2d 1083 (Fed. Cir. 2003) (quoting a treatise to the effect that "it is 'well-settled' law that an inventor's own disclosure will not anticipate his later invention unless that prior work is such as to constitute a statutory bar under § 102(b).") 1 Donald S. Chisum, *Chisum on Patents* § 3.08[2][a] (1999); *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1355, 1336, 66 U.S.P.Q.2d 1331 (Fed. Cir. 2003), "[o]ne's own work may not be considered prior art in the absence of a statutory basis."

Applicants are thus not attempting to prove the specific date of conception of their invention, nor specific acts of diligence from that date until the reduction to practice thereof. Instead, applicants are solely attempting to establish, in accordance with the legal principles set forth above, that the invention disclosed but not claimed in the '574 patent is the invention of the present applicants, and therefore cannot be cited against them under § 102(e). This has been properly done, and it is respectfully requested that the Examiner reconsider the refusal to accept the previously submitted Declaration of Royce S. Fishman to that effect.

Applicants, in addition, now also request the Examiner's reconsideration of the amendment filed on December 11, 2006, which clearly establishes that the claims in this application are in condition for allowance, and such action is therefore respectfully solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which she might have.

Finally, if there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 25, 2007

Respectfully submitted,

By 

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